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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,427	03/10/2004	Edward G. Gatliff	APPLIED 3.0-008	4412
530	7590	08/25/2006	EXAMINER	
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			PALO, FRANCIS T	
			ART UNIT	PAPER NUMBER
				3644

DATE MAILED: 08/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/797,427	GATLIFF, EDWARD G.	
	Examiner Francis T. Palo	Art Unit 3644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 25 May 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,6-9 and 13-26 is/are pending in the application.
- 4a) Of the above claim(s) 13-24 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,7-9,25 and 26 is/are rejected.
- 7) Claim(s) 6 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 10 March 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | Paper No(s)/Mail Date. _____ .  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

## DETAILED ACTION

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-5, 7-9 and 25 have been considered but are moot in view of the new ground(s) of rejection; specifically Applicant's US 5,829,191 patent.

Amendment of the independent claim by incorporation of the claim 2-5 recitations is acknowledged, and as submitted in the prior office action, the incorporation of objected to claim-6 would render the independent claim in condition of allowance.

The submitted deficiencies of the prior art are remedied by applicant's '191 patent, and the indication of allowable subject matter is maintained as regards claim-6.

Claims 1, 6-9, 25 and 26 remain for consideration on the merits, while claims 13-24 remain directed to a non-elected species; claims 13-24 will be rejoined with the allowance of claim-1 however.

### ***Claim Objections***

**Claims 1, 6 and 26** are objected to because of the following informalities:  
Applicant recites in **claim-1**, 'the self-sealing material'; the claim lacks antecedent basis for the limitation, as 'a self-sealing material' has not been positively recited for previously in the claim.

Applicant teaches 'self-sealing material' in two embodiments; as a medium to heavy gauge flexible plastic tubing, and as a sprayed on flexible casing; and further teaches an additive may be added to the walls of the hole to facilitate creation of a seal; the 'self-sealing material' recitation should be changed to, 'the self-sealing casing'.

In **claim-6**, 'the material' should be changed to 'a material'.

**Claim-26** is an awkward recitation.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1 and 7-9** are rejected under 35 U.S.C. 102(b),

as anticipated by or, in the alternative, under 35 U.S.C. 103(a),

as obvious over Applicant's US 5,829,191 patent.

**Regarding amended claim-1:**

Applicant's '191 patent does not merely contemplate the instant elected invention, but rather recites much of the claim language in conflicting '191 claims-1 and 6 wherein, the '191 claim-6 recites 'a flexible casing', as claimed; the self-sealing limitation while not recited in the conflicting '191 claims, is disclosed in the '191 specification at column-3 thereabout line-18.

Further, while a claim preamble is not usually afforded patentable weight for its intended use recitation, the recitation of 'growing commercially valuable trees' is inherently met by the scope of the invention, in that the step of planting a tree in the hole as claimed, requires a commercially grown tree to effect the invention.

**Regarding claim-6:**

The '191 patent does not appear to teach spraying the casing on the walls of the hole as claimed.

Further, it is noted that a sprayable casing constitutes an additional species than that elected and depicted in figures 3-8.

**Regarding claim-7:**

The discussion above regarding claim-1 is relied upon.

The '191 patent appears to be silent as to a biodegradable flexible casing, however, the reference teaches the liner can be a hard or flexible casing or a combination of both,

and that the liner can also be harvested with the tree and its root system such that upon transplantation of the tree, continued long and narrow root development continues (col.-3, second paragraph); the teaching appears to contemplate a disposable casing as claimed, to facilitate the option of not encouraging continued long and narrow root development.

It is submitted therefore, that it would have been obvious to one of ordinary skill in the art at the time the invention was made, to have disposed of the flexible casing after transportation and prior to transplantation so as to not encourage continued long and narrow root development, as contemplated by the '191 teaching.

**Regarding claim-8:**

The discussions above regarding claims 1 and 7 are relied upon.

As discussed above, the '191 reference teaches the liner can also be harvested with the tree and its root system such that upon transplantation of the tree, continued long and narrow root development continues (col.-3, second paragraph); the teaching is considered to read on the broad 'permanent flexible casing' limitation, as claimed.

**Regarding claim-9:**

The discussion above regarding claim-1 is relied upon.

The recitation of 'providing an additive' as claimed, is taught at least in the description of Figure-6, in column-4 of the '191 reference.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 25 and 26** are rejected under 35 U.S.C. 103(a),  
as being unpatentable over Applicant's US 5,829,191 patent,  
in view of Ploeger (US 4,457,102) 1984.

Regarding **claims 25 and 26**:

The discussion above regarding claim-1 is relied upon.

Applicant's '191 patent appears to be silent as to providing a berm-like structure, as claimed; Ploeger teaches a method of growing a commercially valuable crop and depicts in the figures, structure readable on 'providing a berm-like structure' (30), as claimed and, 'a flexible casing that includes a berm-like structure attached to the casing (flared segment of liner (22), as claimed.

It would have been obvious to one of ordinary skill in the art at the time the invention was made, to have modified applicant's '191 casing, to include the berm-like structure as claimed, for the known advantage of that feature, as taught by Ploeger.

***Allowable Subject Matter***

Claim-6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims; (or simply recited in the amended independent claim-1)

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Francis T. Palo whose telephone number is 571-272-6907. The examiner can normally be reached on M-Tu., Th.-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu can be reached on 571-272-7045. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*Francis T. Palo*  
Francis T. Palo  
Primary Examiner  
Art Unit 3644